REMARKS

In the November 15, 2005 Office Action, the Examiner:

- Rejected claims 1-5, 8, 9, 12, 13, 18, 24-26, 29, 31 and 36 under 35 U.S.C. 102(b) as being anticipated by Hilt *et al.* ("*Hilt*", U.S. Pat. No. 5,465,206); and
- Rejected claims 6, 7, 10, 11, 14-17, 19-23, 27, 28, 30, 32-35, and 37-42 under 35 U.S.C. 103(a) as unpatentable over *Hilt* in view of Shirley *et al.* ("*Shirley*", U.S. Pat. No. 5,692,206).

Applicant retains all of the pending claims in their current form, and respectfully presents arguments for their allowability.

Claim Rejections - 35 U.S.C. § 102

The Examiner has rejected claims 1-5, 8, 9, 12, 13, 18, 24-26, 29, 31 and 36 under 35 U.S.C. 102(b) as being anticipated by Hilt et al. For a proper showing that these claims are anticipated by Hilt et al., all elements of each rejected claim must be disclosed in the cited reference. The rejected claims contain two independent claims, namely claims 1 and 36.

With regard to claim 1, the Examiner states that:

> a request (a bill) by a first party (a Biller B) has been formulated for an agreement (an agreement to pay a bill) is sent to a second party (consumer) (See Hilt et al. Fig.4 component 12).

Claim 1 is directed to a method for organizing information around agreements. Agreements are "an understanding or arrangement between two or more people . . .; contract; the terms in which a contract or bargain are set down in writing; a written contract." *See* Websters New Twentieth Century Dictionary, 2nd Ed., at page 38. Hilt et al., however, disclose a payment remittance system. *See* Hilt et al. at Abstract. Remittance in commerce is "the act of transmitting money, bills or the like, as by mail, to a distant place, as in payment for goods." *See* Websters New Twentieth Century Dictionary, 2nd Ed., at page 1529. Remittance, or remote payment, occurs well after an agreement is entered into. For example, the agreement is entered into when the consumer agrees to purchase goods from the biller in exchange for a predetermined amount of money. Later once the agreement has been reached, remittance may occur. Accordingly, a system and method for facilitating the payment of money (remittance) is non-analogous art, i.e., is unrelated to a method for organizing information around agreements.

In particular, transmitting an invoice, as disclosed in Hilt et al., cannot be likened to electronically transmitting a request for an agreement from a first party to a second party. The Biller B in Hilt et al. is not requesting the consumer to enter into an agreement, but is simply instructing the Consumer C to pay the amounts that the consumer has already agreed to pay in consideration for whatever he/she purchased. As such, no request for an agreement is formulated or sent by the Biller B.

The Examiner further states that:

> The request containing an agreement ID (the "BRN or biller reference number) that uniquely identifies the request and any agreement formed therefrom.

Independent claim 1 requires that the request for an agreement contains an "agreement ID that uniquely identifies the request and any agreement formed therefrom." This agreement ID is then used to associate any further correspondence regarding the agreement with the request. Completely unlike the present invention, Hilt et al. teach using a unique biller identification number or biller reference number (BRN) to identify the biller to the payment network. *See* Hilt et al. at Abstract and col. 10, ll. 47-49. In other words, the BRN is used to identify the biller and not a particular payment or transaction, let alone a particular agreement. Even if the system disclosed by Hilt et al. applied to agreements, which it clearly does not, if the biller sent a new and different invoice to the consumer, where the new invoice related to a new and different transaction, the BRN identifying the biller would remain the same. In other words, the BRN does not relate to a particular transaction, but rather simply identifies the biller to facilitate payment to the biller. Hilt et al. simply does not disclose, teach, or suggest an ID that uniquely identifies the particular remittance transaction, let alone an agreement ID that "identifies the request for an agreement and any agreement formed therefrom," as required by claim 1. For this reason alone, Hilt et al. cannot anticipate independent claim 1 or the claims that depend therefrom, as Hilt et al. do not disclose, teach, or suggest all of the elements of the claim.

The Examiner further states that:

> The second party then returns correspondence (a bill pay order 122) to the first party (the biller) over the same network (102).

Independent claim 1 has been amended to clarify that the first party receives the correspondence regarding the request, or any agreement formed therefrom, from the second party. Hilt et al. teach that the consumer sends a bill pay order to the consumer's bank; the

consumer's bank submits a payment message to the biller's bank; and the biller's bank then supplies accounts receivable (A/R) data to the biller. The bill pay order is never received by the biller. In other words, Hilt et al. does not disclose that the consumer transmits anything to the biller, or that the biller receives any electronic communication from the consumer, let alone electronic correspondence to the regarding a request or agreement formed therefrom. For this reason alone, Hilt et al. cannot anticipate claim 1, as it does not teach that agreement correspondence is received by the first party from the second party.

Still further, the Examiner states that:

> The order is processed and saved on the biller's ledger (42) (See Hilt et al. Fig.4, component 14 in conjunction with element (42).

While Hilt et al. do teach saving A/R data on the biller's ledger, they do not teach saving correspondence from the second party. The A/R data is never received from the consumer, but is rather received from the biller's own bank. Moreover, As Hilt et al. do not disclose the use of an Agreement ID (see above), they cannot disclose saving the correspondence according to the unique agreement ID. In fact, if, as the Examiner argues, the A/R data is saved according to its unique BRN (the biller's identification number), then all A/R data would be saved under the same BRN, as the biller's identification number remains the same for all payments. This makes no sense in the context of the present invention. For these reasons alone, Hilt et al. cannot anticipate independent claim 1 or any of the claims that depend therefrom.

Based on the above, Hilt et al. cannot possibly anticipate independent claim 1. Therefore, it is respectfully requested that these rejections be withdrawn.

With regard to independent claim 36, the Examiner states:

> As per claim 36, the claim has substantially the same limitations as claim 1. These limitations have already been discussed in the rejection of claim 1. In addition, Hilt et al. disclose, the claimed limitations of: linking the second agreement to the first agreement by including the first agreement ID in the field identifying a downstream agreement to form a supply chain among the first, second and third parties (See Hilt et al. Figs. 1-3,7,11 and col.4, lines 7-23; col.17, lines 46-67; col.20, lines 36-67). Therefore, it is rejected on similar grounds corresponding to the argument given for the rejected claim 1 above.

For at least the reasons stated above, claim 1 cannot possibly be anticipated by Hilt et al. In addition, Hilt et al. does not disclose any systems or methods that relate to managing agreements to form a supply chain. In fact, other than blanket citations to large paragraphs of text from Hilt et al., the Examiner provides no evidence that each element of independent claim 36 is disclosed, taught, or suggested by Hilt et al. In addition, Hilt et al. does not disclose many of the other elements of this claim, as set forth below.

First, Hilt et al. does not disclose "formulating and sending . . . a first request by a first party . . . and receiving a first acceptance over the computer network from a second party." Again, Hilt et al. relates to a remittance system, which does not relate to requesting an agreement and receiving an acceptance of the agreement. In Hilt et al., Consumer C never electronically communicates with Biller B. It is unclear from the Examiner's rejection which communication is being relied on for this element, let alone anything that could be construed as an agreement. If the Examiner is referring to the communication between the Consumer C and Bank C, or between Bank C and the Settlement Bank, or between Bank B and the Biller B, then no agreement is formed, as the Consumer C simply pays Bank C, which pays the Settlement Bank, which pays Bank B. No request for an agreement or acceptance of an agreement is sent or received. Rather, instructions to pay are sent between the parties.

Second, Hilt et al. does not disclose that the request and acceptance "form a first agreement between the first party and the second party." As described above, Hilt et al. do not disclose any agreements. The remittance described in Hilt et al. occurs long after an agreement is reached. Simply sending an invoice or making a payment cannot reasonably be interpreted as forming an agreement.

Third, Hilt et al. do not disclose that the first agreement has a unique first agreement ID. As support for the agreement ID, the Examiner relies on the BRN or biller identification number disclosed in Hilt et al. This BRN only identifies the biller and cannot be reasonably interpreted to cover a unique agreement ID for a first agreement. Moreover, Hilt et al. does not disclose, teach or suggest a first agreement that specifies "a first deliverable to be received by the first party." A deliverable is defined in paragraph 0085 of the specification as "either a physical item or an action, the goal of the agreement."

Fourth, for the same reasons as presented above, Hilt et al. do not disclose forming a second agreement between the second party and a third party. Hilt et al. also do not disclose a second agreement that includes a field for identifying a downstream agreement. Again, if the Examiner is relying on the BRN as the identifier, the BRN never changes in Hilt et al., so

there is no identification of a downstream agreement different to the second agreement. As such, for this reason alone, Hilt et al. cannot anticipate claim 36, as it does not disclose, teach, or suggest all of the elements of the claim.

Fifth, Hilt et al. do not teach "linking the second agreement to the first agreement by including the first agreement ID in the field identifying the downstream agreement to form a supply chain among the first, second and third parties." Hilt et al. do not discuss fields at all, let alone linking any agreements using different agreement IDs.

In light of the above, it is clear that Hilt et al. cannot anticipate independent claim 36 or any of the claims that depend therefrom. Therefore, it is respectfully requested that these rejections be withdrawn.

With regard to dependent claims 2 and 24 the Examiner states:

> The first client computer system (the client computer of Biller B) has an independent database (ledger 42) that stores the requests (bills) submitting by Biller B and the correspondence (payment) made via the bill pay orders (See Hilt et al. Fig.4; col. 12, line 41 through col. 13,linel7).

As shown above, claim 1 is not anticipated by Hilt et al. Therefore, dependent claims 2 and 24, which include all of the limitations of independent claim 1, also cannot be anticipated by Hilt et al. Moreover, as shown above, the Biller B of Hilt et al. never receives any electronic correspondence from the Consumer C. Therefore, Hilt et al. cannot teach "saving the correspondence from the second party . . . in the agreement database . . .," as required by claims 2 and 24. Hilt et al. also does not teach that the correspondence is saved in a "record that includes or is linked to the agreement." As such, it is respectfully submitted that Hilt et al. also cannot anticipate dependent claims 2 and 24.

With regard to dependent claims 3, 12,25 and 31 the Examiner states:

> Hilt et al, disclose an acceptance in the form of the bill pay order (See Hilt et al. Figs.4,6,7 and 8 component 122).

With regard to independent claim 1 the Examiner referred to the Biller B and the Consumer. Now, the Examiner refers to the "bill pay order," which is sent from the Consumer C to the Consumer's Bank C. These parties are different to those previously relied on by the Examiner and bear no bearing on the prior rejections presented by the Examiner. In any event, this claim cannot be anticipate by Hilt et al. for at least two reasons. First, Hilt et al. does not disclose that the Consumer C ever sends correspondence to the Biller B, let alone an acceptance of an agreement. Second, the "bill pay order" disclosed in Hilt et al. is nothing

more than an instruction from the Consumer C to his/her Bank C to pay the biller's Bank B. No reasonable interpretation of an acceptance of an agreement encompass an instruction to pay.

With regard to dependent claims 4,9, 13 and 18 the Examiner states:

> Hilt et al. disclose the method wherein the bill pay order is in an electronic mail message which is encapsulated to include the agreement ID "BRN" (See Hilt et al. col.13, lines 50-53).

These claims relate to the correspondence from the second party back to the first party that formulated and transmitted the request. Again, Hilt et al. discloses a bill pay order that is sent from the consumer to his/her bank not to the biller. Accordingly, the bill pay order cannot be the correspondence. While, Hilt et al. do disclose that the pull pay can be sent electronically, Hilt et al. do not disclose that the bill pay order can be sent via electronic mail. For these reasons, Hilt et al. cannot anticipate these claims.

With regard to dependent claims 5, 8, 26, 29 the Examiner states:

> Hilt et.al. disclose the method wherein the bill pay order is in an electronic message is a correspondence from the second party which includes a main body of information and an attachment to the main body; and wherein the attachment is according to the agreement ID on how to proceed with the transactions (See Hilt et al. col. 11, lines 9-46; col. 13, lines 17-4 1 ; col. 14, lines 19-49).

Again, Hilt et al. do not disclose (i) correspondence from the second party back to the first party that formulated and transmitted the request, and (ii) that the bill pay order can be sent via electronic mail. In addition, Hilt et al. does not mention attachments to electronic messages at all, let alone that attachment is according to the agreement ID. Accodingly, Hilt et al. cannot anticipate these claims either.

Claim Rejections - 35 U.S.C. § 103

The Examiner has rejected claims 6, 7, 10, 11, 14-17, 19-23, 27, 28, 30, 32-35, and 37-42 under 35 U.S.C. 103(a) as unpatentable over *Hilt* in view of *Shirley*. To establish a prima facie case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The Examiner relies on the primary reference of Hilt et al. to show all of the limitations of the independent claims 1 and 36. However, as shown above, Hilt et al. fails to teach most of the limitations of these independent claims. Accordingly, claims 6, 7, 10, 11,

14-17, 19-23, 27, 28, 30, 32-35, and 37-42 cannot be unpatentable over *Hilt* in view of *Shirley*, as the prior art references do not teach or suggest all of the claim limitations.

CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is now in a condition for allowance. However, should the Examiner believe that the claims are not in condition for allowance, the Applicant requests an interview with the Examiner and the Examiner's supervisor at the earliest possible opportunity.

If there are any fees or credits due in connection with the filing of this Amendment, including any fees required for an Extension of Time under 37 C.F.R. Section 1.136, authorization is given to charge any necessary fees to our Deposit Account No. 50-0310 (order No. 63898-5001-US). A copy of this sheet is enclosed for such purpose.

Respectfully submitted,

Date: April 14, 2006

45,645
Dion M. Bregman (Reg. No.)
MORGAN, LEWIS & BOCKIUS LLP
2 Palo Alto Square
3000 El Camino Real, Suite 700
Palo Alto, California 94306
(650) 843-4000